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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/762,663
Filing Date: January 22, 2004
Appellant(s): TADYCH, JOHN E.

Alan H. Wagner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/14/08 appealing from the Office action mailed 3/23/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2 and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. US 6,929,857.

Watanabe et al. shows rubber compositions based on vulcanized rubber latex ingredients, see column 3 lines 50-55. The incorporation of aqueous ammonia is suggested at column 4 lines 5 and 6 as well as the examples. The abstract of this patent describes the utility of the latex composition as a "treating agent" for glass fiber wherein the treating agent forms a coating film on said glass fiber. The claims on appeal are directed to "a masking compound." The specification describes the masking compound as being capable of forming a rubber "membrane" on a surface. This is seen to read on a film forming coating on a surface. As such, the "masking compound" is seen to read on the film forming rubber composition shown in the Watanabe et al. patent.

The closest teaching is seen to be the examples of the patent. Examples 2, 3 and comparative examples 3 and 4 show the use of aqueous ammonia with the rubber latex as claimed. The only difference between this disclosure and the claimed invention is the incorporation of the filler. The fillers are suggested at column 3 lines 51+ and specified at column 6 lines 35+. One would be motivated to incorporate the fillers

shown here in the compositions given that the patent expressly teaches the fillers and one of ordinary skill would have a reasonable expectation of the resultant properties. As such, the claims are rendered *prima facie* obvious from this disclosure.

(10) Response to Argument

The first argument advanced by appellant alleges that the art fails to use a vulcanized rubber. This does not patentably distinguish the claimed invention from the art. The patent teaches and exemplifies vulcanizing agents. Further, the art shows conditions under which the latex would be vulcanized. As such, one would expect the rubber latex to be vulcanized and the limitation is anticipated. Further, there is no lower limit of vulcanized rubber latex. A trace amount of vulcanized rubber in the latex anticipates the limitation as well. Either way, the limitation is anticipated. There is no question of obviousness with respect to this limitation and, as such, no need to answer appellant's question as to why one would find the presence of vulcanized rubber obvious.

Appellant's polymeric argument attempts to distinguish the claimed invention from the art based on the preamble language "masking compound." This language has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190

USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Appellant's allege that the preamble language, some how, limits the use of the product and further alleges that the use of a product has patentable weight when the properties of the product depend on the use. This can not be found persuasive. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The claimed "masking compound" is a coating composition. There is no claim limitation that reflects the "sacrificial" nature of the composition. The coating composition of the prior art is seen to possess properties that render it capable of functioning as a "masking compound." The fact that the art heats the coating and intends for the coating to be permanent does not render the claims patentable. The coating composition of the prior art is capable of being used as a "masking compound" as claimed.

The third argument advanced by appellant's questions the operability of the vulcanized latex of the prior art having pre-vulcanized rubber in the latex rather than in situ vulcanization. The claims read upon trace amounts of vulcanized rubber latex. Further the claims are open to other ingredients, such as unvulcanized rubber latex, and vulcanizing agents and further in situ vulcanizing as shown in the art. The art does not teach any defects resulting from vulcanized rubber. To the contrary, vulcanizing is

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taught and vulcanized rubber latex is not excluded. Continuous networks comprising pre-vulcanized rubber are well known and obtainable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Peter D. Mulcahy/

Primary Examiner, Art Unit 1796

Conferees:

/David Wu/

Supervisory Patent Examiner, Art Unit 1796

/James J. Seidleck/

Supervisory Patent Examiner, Art Unit 1796